

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-23 are rejected under 35 U.S.C. 112.

Also, claims 1, 20-23 are rejected under 35 U.S.C. 102(b) over the patent to Ratley.

Claims 5-13 and 19 are rejected under 35 U.S.C. 103(a) over the patent to Jarus in view of the patent to Weber and Minamedati.

Finally, claim 18 is rejected under 35 U.S.C. 103(a) over the patent to Jarus, in view of the patent to Weber and Minamedati and Ratley.

In connection with the Examiner's formal objection of the claims, claim 1 has been amended to more clearly define the present invention.

It is believed that the Examiner's grounds for the objection of the claims under 35 U.S.C. 112 is considered as no longer tenable and should be withdrawn.

Turning now to the Examiner's objection of the claims over the art, and in particular claim 11, it is respectfully submitted that claim 1 defines a handle which has a gripping part and a separate mounting part whereby the gripping part is connected with the mounting part through the movable safety element which is movable relative to the gripping part.

In the Examiner's opinion the lower joint 32 disclosed in the patent to Ragley serves as a mounting part. For such mounting part no elastic element is mounted since the elastic element would be a part of the mounting part and is not mounted on the mounting part. An elastic element "mounted on" means in the applicant's opinion a separate part from the mounting part, as now specified in claim 11.

It is correct that the handle disclosed in the patent to Ragley includes cylindrical members 42, 44 serving as mounting parts. They are separate from the elastic element. However, they are not separate from the gripping part as defined in claim 11. Furthermore, as defined in claim 11, the

gripping part is connected with the mounting part through a movable safety element. The patent to Ragley does not disclose any safety element at all. The bolt and nut combination 52 is clearly not a safety element. Its purpose is to "hold the lower joint 32 together" as defined in column 5, line 1. It should be emphasized that the safety element is an element for safety purposes and clearly not an element if it is necessary in any event such as the bolt and nut combination 52.

The additional difference as defined in claim 11 over the patent to Ragley is that the safety element is movable relative to the gripping part during a predetermined operation. The bolt and nut combination 52 disclosed in the patent to Ragley is clearly fixed to the gripping element during a predetermined operation and not movable as claimed.

The original claims were rejected over the patent to Ragley under 35 U.S.C. 102(b) as anticipated. In connection with this, applicant wishes to cite the decision in re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Ragley does not disclose all elements as defined in claim 11, in their specific order and also in their interaction and interjunction.

It is therefore believed that the original rejection of the claims as anticipated over the patent to Ragley should be considered as no longer tenable and should be withdrawn.

Turning now to the Examiner's rejection of claim 11 as being obvious from the patent to Jares in combination with the patents Weber and Minamidate, it should be mentioned that the safety element is movable "to avoid a passage of vibrations through the safety element" in the applicant's invention and this is not disclosed in any of the references.

The Examiner indicated that the patent to Minamidate shows this feature in Figure 1. However, Figure 1 of this reference shows a rod 3 which is not movable to avoid a passage of vibrations through it. In the patent to Minamidate it is clearly stated that the rod is formed for transmitting vibrations, as disclosed on page 2, column 1, lines 35-44. As specifically

explained in the previous Amendment the whole mechanism of the patent to Minamidate does only work if the tie rod 3 transmits vibrations.

The other references applied in combination also do not teach the new features of the present invention as defined in claim 11. It is therefore believed to be clear that the present invention as defined in claim 7 can not be derived from the references as a matter of obviousness.

In order to arrive at the applicant's invention from the references which were combined by the Examiner, it is necessary to significantly modify the references, in particular by introducing into them the new features of the present invention which are now defined in claim 11. It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference

to modify its structure to one which prior art references do not suggest.

Definitely, the references do not disclose any hint or suggestion for such modifications.

It is believed that claim 11 together with claims which depend on it should be considered as patentably distinguishing over the art and should be allowed.

As for the Examiner's rejection of claims 20-23, in the Examiner's opinion the safety element in the patent to Ragley is connected to the gripping part exclusively by the elastic element.

In the patent to Ragley the bolt and nut connection 52, apart from not being any safety element is directly connected to the gripping part via the cylindrical members 42, 44. It is therefore not connected to the gripping part via the elastomeric sleeves 56 and not at all exclusively via the sleeves 56.

As for claim 21, the Examiner indicated that the safety element in the patent to Ragley is completely surrounded by the elastic element. As can be clearly seen from the patent to Ragley, the bolt and nut combination

52 is not completely surrounded by the elastomeric sleeves 56, but only by some sections. The upper and lower ends of the bolt and nut combination 52 for example are free as well as the middle section.

The same is true with respect to claim 22. The patent to Ragley does not show any distance as claimed filled with the elastic material as defined in claim 22.

Claim 23 together with the amended claim 1 clearly distinguishes from the patent to Ragley as well, since both the gripping part and the separate mounting part shall show discs, which is not disclosed in the patent to Ragley.

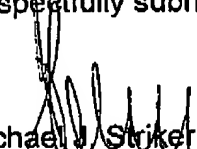
It is therefore believed that claims 20-23 should also be considered as patentably distinguishing over the art and should be allowed.

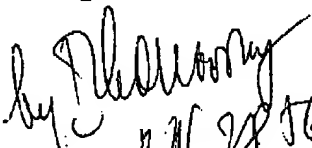
Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in

formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

  
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12/18/04